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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/673,093

09/26/2003

Steven E. Brown

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EXAMINER

ALEXANDER, LYLE

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

02/10/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/673,093	Applicant(s) BROWN ET AL.	
	Examiner Lyle A. Alexander	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7,9-11,13-29,31-34,56-58,60 and 135 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,9-11,13-29,31-34,56-58,60 and 135 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5,7, 9-11, 13-29, 31-34, 56-58,60 and 135 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-66 and 1-43 of copending Application No. 10/650,124 and 10/649,347 respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the claims are directed to methods of selecting a particulate material based upon the properties of the particles.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5,9-11, 13-29, 31-34, 56-58,60 and 135 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cuch et al. (USP 6,482,883).

Independent claims 1 and 56 state the performance property could be either “homogeneous interaction ...” or “heterogeneous interaction ...”. For the purposes of examination, the Office will consider the “homogeneous interaction” alternative.

Furthermore, the 5/9/08 election of species elects “interfacial potential by wicking rates.” In light of the election, the Office will interpret the “homogeneous interfacial parameters” as a “wicking rate.”

Cuch et al. teach an ink jet coating composition comprising a pigment of blended of silicas, a blend of polyvinyl alcohol and a cationic resin. The silicas have been read on the claimed “particulate material” and the polyvinyl alcohol/cationic resin have been read on the claimed “matrix.” Column 3 lines 51-56 teach the silica is fumed silica which is identical to that of claim 9. Columns 9-10 lines 18+ teach testing the ink composition's image density by the “Black Wicking Rating” or BWR. The BWR testing has been read on the claimed “homogeneous interaction parameter ... relates to how the particulate material interacts with itself ...” .

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cuch et al. in view of Sampei (USP 7,021,213).

See Cuch et al. supra.

Cuch et al. teach the particulate material is a silica and are silent to the claimed carbon black and metal oxide pigments.

Sampei teach in column 39 "Table 1" an ink composition that contains the pigment particles of metal oxides, carbon black and silica.

It would have been obvious to simply substitute one known element for another to obtain predictable results. In this instance, the ink pigment particules have been equated to the "known element." It would have been obvious to simply substitute one known ink particulate blend, such as that taught by Sampei, for the ink particulate blend taught by Cuch et al. This substitution would result in the BWR test taught by Cuch et al. being performed on an ink particulate blend containing silica, carbon black and metal oxides which has been properly read on claims 6-8.

Response to Arguments

Applicant's arguments filed 12/5/08 have been fully considered but they are not persuasive.

Applicants traverse the provisional obviousness-type double patenting rejections by stating the Office has not provided any reasoning in support of the rejections. The

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Office maintains the instant claim language is sufficiently broad to have been properly read on the cited application that also measure properties of particles.

Applicants traverse the 35 USC 102 rejections on the basis the cited prior art “Cuch” fails to teach any “measurement or understanding of the silica and how the silica interacts by itself with respect to wicking.” The Office maintains Cuch teaches silica in the ink composition and the taught analysis of the ink composition inherently includes the analysis of the silica. The claims are sufficiently broad to have been read on Cuch and do not exclude the addition compounds in the ink composition of Cuch.

Applicants also state the “BWR” rating/analysis of Cuch is related to how well an image can be printed on piece of paper and cannot be read on the claimed “homogeneous interaction parameter.” The instant claim language requires measuring the interaction of the particle with itself and a matrix which has been properly read on the taught interaction of the ink with the paper (e.g. read on the claimed matrix).

The remainder of Applicants’ remarks traversing the 35 USC 102(b) rejections state the claimed “interfacial potential of wicking rate described in, for instance, paragraph [065] ...” are different from those taught by Cuch. These remarks are not commensurate in scope with the pending claims that do not contain these limitations.

Applicants’ traverse the 35 USC 103 rejections on the basis that Cuch is unrelated to the instant invention. The Office maintains, as explained above, the instant claims are sufficiently broad to have been properly read on Cuch and the 35 USC 103 rejections are proper.

Conclusion

This is a RCE of applicant's earlier Application No. 10/673,093. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Tuesday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application
may be obtained from the Patent Application

/Lyle A Alexander/
Primary Examiner, Art Unit 1797

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Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.